

Attorney Docket No.: SYM114 (TI-0029)
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REMARKS

Claims 1-30 are pending in the instant application. Claims 1-30 have been rejected. Claims 1, 2, 5, 10, 11, 13, 16, 17, 20, 25, 26 and 28 have been amended. Claims 4, 7, 9, 12, 14-15, 19, 22, 24, 27 and 29-30 have been canceled. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Rejection of Claims 3, 4, 6-15, 18, 19 and 21-30 under 35 U.S.C. § 112, first paragraph

The Examiner has maintained the rejection of claims 3, 4, 6-15, 18, 19 and 21-30 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the Examiner suggests that there is no evidence of record that Applicants compounds have shown clinical efficacy for every disorder claimed herein. Further, the Examiner suggests that the compounds are not art recognized as being useful for such purposes.

Applicants respectfully traverse this rejection.

At the outset, Applicants respectfully disagree with the

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Examiner's suggestion that Applicants must show clinical efficacy of every disorder taught in the specification to meet the enablement requirements of 35 U.S.C. § 112, first paragraph, particularly with respect to pending composition claims 3, 6, 8, 18 and 21. The Examiner acknowledged in the Office Action of September 25, 2002 that the specification is enabling for use of the compositions in ischemia. Accordingly, since the composition claims of 3, 6, 8, 18 and 21 are not limited by a recited use, the acknowledged enablement of use in ischemia precludes a rejection of these claims for lack of enablement. See MPEP § 2164.01(c) which states that "if any use is enabled when multiple uses are disclosed, the application is enabling for the claimed invention".

Further, in an earnest effort to advance the prosecution of this case, and in accordance with the Examiner's acknowledgement that 2,3-benzodiazepine AMPA antagonists have been recently identified as useful in treatment of acute neurological diseases such as brain ischemia, stroke and brain or spinal cord trauma, Applicants have amended claims 10 and 25 to be drawn more specifically to methods for treating a patient suffering from ischemia, epilepsy or stroke. Support for this amendment is provided in the specification at page 2, lines 21-23 and page 6,

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lines 16-18 Applicants have canceled claims 4, 7, 9, 12, 19, 22, 24, 27 and 29-30.

Withdrawal of this rejection under 35 U.S.C. § 112, first paragraph, is respectfully requested in light of the above remarks and the amendments to the claims.

II. Rejection of Claims under 35 U.S.C. § 112, second paragraph

The Examiner has maintained 35 U.S.C. § 112, second paragraph rejections labeled h), j), k), t), u), y), ab), ac), ak), al), and am) in the Office Action dated September 25, 2002.

In particular, in part h) the Examiner rejected claims 3, 4, 6-15, 18, 19, 21-27, 29 and 30 as being vague and indefinite in that the claim provides for the use of claimed compounds but does not set forth any steps involved in determining which are the diseases capable of being mediated by inhibiting the activity of AMPA subtype of the ionotropic EAA receptor.

Accordingly, in an earnest effort to advance the prosecution of this case, all pending claims wherein use of the compound is specified have been amended to state that the patient is suffering from ischemia, stroke or epilepsy. Support for this amendment can be found throughout the specification, for example at page 2, lines 21-23 and page 6, lines 16-18.

In part j) and k), part t) and u), part ab) and ac), and

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part al) and am), claims 5, 13, 20 and 28 were rejected for insufficient antecedent basis for the terms "7-amino" and "8-amino". In particular, the Examiner suggests that claim 5, which is dependent from claim 2, claim 13, which is dependent from claim 11, claim 20, which is dependent from claim 17 and claim 28 which is dependent from claim 26 lacks antecedent basis in that the definition of R^1 , R^2 , R^3 and R^4 , fails to include $R^{15}R^{16}N$ -. Accordingly, in an earnest effort to advance the prosecution of this case, claim 5 has been amended to depend from claim 1, claim 13 has been amended to depend from claim 10, claim 20 has been amended to depend from claim 16 and claim 28 has been amended to depend from claim 25, each of which include $R^{15}R^{16}N$ -.

In part y) the and ak) Examiner suggests that claim 17 and claim 20 lack antecedent basis for the term $R^{13}S$ -. Accordingly, in an earnest effort to advance the prosecution, the term $R^{13}S$ - has been placed in claims 16 and 19 from which claims 17 and 20 depend. Support for this amendment is provided in the specification at page 11, lines 4-7 and page 16, lines 24-27.

No new matter is added by these amendments.

Withdrawal of these rejections under 35 U.S.C. § 112, second paragraph, is respectfully requested in light of these amendments.

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III. Rejection of Claims 1-30 under 35 U.S.C. § 102(a) and 35
U.S.C. § 103(a)

Claim 1-30 have been rejected under 35 U.S.C. § 102(a) as being anticipated by Ling et al. (WO 97/28135). Claims 1-30 have also been rejected under 35 U.S.C. § 103(a) as being unpatentable over Ling et al. (WO 97/28135). The Examiner suggests that Ling et al. teaches the compounds, compositions and method of use of the instant invention where R¹ is hydrogen, R² is methoxy, R³ is hydrogen, bromo or chloro, R⁴ is hydrogen, R⁵ is hydrogen, R⁶ is hydrogen, R⁷ is methyl, R⁸ is hydrogen, R⁹ is C(=O)CH₃, C(=O)NHCH₃, C(=O)CH₂CH₃, C(=O)cyclopropyl, C(=O)OCH₃, R¹⁰ is NH₂, R¹¹ is hydrogen and R¹² is hydrogen for Formula I and R¹⁸ is hydrogen, R¹⁹ is hydrogen, R²⁰ is NH₂, and R²¹ is hydrogen for Formula II.

Accordingly, in an earnest effort to advance the prosecution of this case, Applicants have amended the claims to state that one of the substituents of R¹, R³ and R⁴ must be C1-C3-alkoxy or C1-C3-alkylthio group.

Ling et al. does not teach or suggest compounds wherein one of the substituent of R¹, R³ or R⁴ must be C1-C3-alkoxy or C1-C3-alkylthio group. Accordingly, this reference can neither anticipate nor render obvious the claims as amended.

Withdrawal of these rejections under 35 U.S.C. § 102(a) or

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35 U.S.C. § 103(a) is therefore respectfully requested.

IV. Rejection of Claims 1-4, 8-12, 16, 23-25 and 30 under 35

U.S.C. § 112, first paragraph - Written Description

Claims 1-4, 8-12, 16, 23-25 and 30 have been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. In particular, the Examiner suggests that the amendment with respect to the definition of R^1 , R^2 , R^3 and R^4 where R^1 , R^2 , R^3 and R^4 is $R^{14}S$ - is not described in the specification for the genus. The Examiner suggests that the definition of R^{14} is such that R^{14} is H or C1-C3-alkyl.

Thus, in an earnest effort to advance the prosecution, Applicants have deleted this term from the claims.

Withdrawal of this rejection is therefore respectfully requested.

V. Rejection of Claims 1-4, 8-12, 16-19, 23-27 and 30 under 35

U.S.C. § 112, second paragraph

Claims 1-4, 8-12, 16-19, 23-27 and 30 have been rejected under 35 U.S.C. § 112, second paragraph as being indefinite for

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failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, the Examiner suggests that the claims are vague and indefinite for inclusion of the capitalized term "Halogen". Accordingly, this term has been replaced in all claims with --halogen--. Support for the term --halogen-- can be found in the specification at page 8, line 8 and page 10, line 11 of the specification.

Claims 2-4 have also been suggested to be vague and indefinite for improper Markush grouping with respect to R⁹. Applicants have amended the claims to correct this inadvertent error as well.

Withdrawal of these rejections under 35 U.S.C. § 112, second paragraph, is respectfully requested in light of these amendments.

VI. Rejection of Claims 1, 8-10 and 15 under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1, 8-10 and 15 under 35 U.S.C. § 103(a) as being unpatentable over Csuzdi et al. (U.S. Patent 6,323,197). The Examiner suggests that the generic structure of Csuzdi encompasses the instantly claimed compounds and for the same uses as claimed herein.

As discussed in Section III, *supra*, however, Applicants have

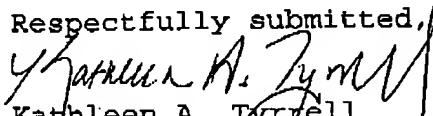
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amended the claims to state that one of the substituents of R¹, R³ and R⁴ must be C1-C3-alkoxy or C1-C3-alkylthio group. Csuzdi et al. does not teach or suggest compositions wherein one of the substituents of R¹, R³ and R⁴ must be C1-C3-alkoxy or C1-C3-alkylthio group. Accordingly, this reference does not teach or suggest all the limitations of the claims and therefore cannot render obvious the claims as amended. See MPEP § 2143.

Withdrawal of this rejection under 35 U.S.C. § 103(a) is therefore respectfully requested.

VII. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

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